



UNITED STATES PATENT AND TRADEMARK OFFICE

JP

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/997,588 | 11/29/2001 | Chen Xing Su | 10209.353 | 6233 |

21999 7590 12/01/2004

KIRTON AND MCCONKIE
1800 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
P O BOX 45120
SALT LAKE CITY, UT 84145-0120

| |
|----------|
| EXAMINER |
|----------|

LEITH, PATRICIA A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1654

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/997,588 | SU ET AL. | |
| | Examiner | Art Unit | |
| | Patricia Leith | 1654 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 September 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 4-28 is/are pending in the application.
 4a) Of the above claim(s) 13-23, 27 and 28 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1, 4-12 and 24-26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/7/04 has been entered.

Claims 1 and 4-28 are pending in the application.

Claims 13-23 were withdrawn from further consideration on the merits as being drawn to a non-elected invention per the election without traverse in the Office Action dated 6/18/03. Claims 27 and 28 were also withdrawn from consideration as being drawn to a non-elected invention due to election by original presentation in the Office Action dated 2/11/03.

Claims 1 , 4-12 and 24-26 were presented for examination on the merits.

Claim Rejections - 35 USC § 112

Claims 1 and 9 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim (s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors), at the time the application was filed, had possession of the claimed invention.

Applicants' arguments were fully considered, but not found persuasive

Applicant has quantified 'more than 1 oz' to 'not encompass 100 ounces, but the broadest reasonable interpretation of "more than 1 oz." necessarily includes 3 ounces'. However the Examiner disagrees for the reasons already set forth on the record. Further, it appears that Applicant is assigning arbitrary amounts to 'more than 1 oz' which are not substantiated or defined in the Instant specification. Although the original disclosure stated 'more than 1 oz' it is the opinion of the Examiner that any definite amounts greater than 1 ounce are not specifically described in the Specification and therefore it cannot be absolutely determined if Applicant's actually contemplated such a specific amount of noni juice.

Claim Rejections - 35 USC § 103

Claims 1, 4-12 and 24-26 are newly rejected under 35 U.S.C. 103(a) as being unpatentable over Mumford (1998) in view of Brock et al. (1991), in view of Gagnon (1997) in view of Nahir (EP 0 555 573 A1) and further in view of the Associated Press, Buffalo News (11/1996).

The crux of this rejection can be found in previous Office Actions.

Applicant has amended the claims to require that the method include administration of a fruit juice or vegetable juice. None of the references specifically taught wherein Morinda citrifolia juice was mixed with a fruit or vegetable juice.

It is noted that in the article by Mumford, that Morinda citrifolia juice tastes 'terrible' (see page 1).

Mixing known medicines with juices such as orange juice was well known in the art at the time the invention was made. For example, the Associated Press, Buffalo News (11/1996) reported that soy protein powder, administered for hot flashes, was mixed with orange juice prior to ingestion (see p. 1, second paragraph).

One of ordinary skill in the art would have been motivated to mix noni juice with a juice such as orange juice in order to inhibit the terrible taste of the noni juice.

Applicant argues that the previous references did not teach wherein *Morinda citrifolia* was mixed with another juice (p. 13- Arguments). This argument is without merit in that the previous claims did not state wherein *Morinda citrifolia* juice was added to another juice for administration and thus these arguments are rendered moot, especially considering the new rejection set forth *supra*.

Applicant argues that Mumford teaches a treatment for migraine headaches which are caused by vasoconstriction of blood vessels, different than the present invention which 'seeks to reduce free radicals in the body, which are caused by oxygenation' (p.14, Arguments). However, as it was clearly pointed out in previous Office Actions, the step in the method only includes administration to a patient. Every person has free radicals in the body and therefore administration of noni juice would have been an intrinsic consequence of administering noni juice, even though this particular mechanism may not have been known in the art.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia Leith
Primary Examiner
Art Unit 1654

11/19/04

